

**REMARKS**

Reconsideration is requested.

Claims 1, 6 and 10 have been revised, without prejudice, as further detailed below.

Claims 2 and 15 have been rewritten in independent form.

Claims 16-20 have been revised to depend, directly or indirectly, from claims 1, 2, 6, 10 or 15.

Claim 19 has been further revised in the manner described below.

Claims 21-23 have been added and are similar to claims 3-5 but are dependent from claim 2.

No new matter has been added.

Claims 1-23 are pending.

The Examiner's detailed comments relating to the art statements and correction of the record with regard to the same are acknowledged, with appreciation. The Examiner is requested to provide a completely initialed copy of the following partially-initialed PTO 1449 Form:

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Appl. No. 10/554,099  
Atty Ref.: 1114-218  
Amendment  
August 18, 2008

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INFORMATION DISCLOSURE CITATION		ATTY. DOCKET NO.	SERIAL NO.
		1114-218	10/554,099
APPLICANT		ISHIDA ET AL.	
FILING DATE		GROUP	1795
October 21, 2005		2832	

U.S. PATENT DOCUMENTS

EXAMINER INITIAL	DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE
JLD	4,725,519	2-1988	Suzuki et al.			
	4,471,039	9-1984	Borsenberger et al.			
	4,557,868	12-1985	Paga et al.			
	4,898,799	2-1990	Fujimaki et al.			
	6,210,847	4-2001	Miyachi et al.			
	6,485,658	11-2002	Horiuchi et al.			
	5,132,197	7-1992	Iuchi et al.			
	5,292,604	3-1994	Nukada et al.			
	4,981,767	1-1991	Tokura et al.			
	4,971,677	11-1990	Miyamoto et al.			
	5,106,536	4-1992	Miyamoto et al.			
	2004/0101770 A1	5-2004	Obata et al.			
	5,595,846	1-1997	Shigematsu et al.			
JLD	6,150,063	11-2000	Suginura et al.			

FOREIGN PATENT DOCUMENTS

DOCUMENT	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION YES NO
JLD	5-55860 B2	8-1993	JP		partial
	59-155851 A	9-1984	JP		partial
	2-233769 A	9-1990	JP		partial
	61-28557 A	2-1986	JP		partial
	7-91486 B2	10-1995	JP		partial
	2700859 B2	10-1997	JP		partial
	2000-129155 A	5-2000	JP		partial
	3-128973 A	5-1991	JP		partial
	2000-313819 A	11-2000	JP		partial
	4-372663 A	12-1992	JP		partial
	9-73182 A	3-1997	JP		partial
JLD	2-84661 A	3-1990	JP		partial
JLD	2-170166 A	8-1990 06-1990	JP		partial
JLD	10-90926 A	4-1988	JP		partial
JLD	4-351673 A	12-1992	JP		partial
JLD	2002-23396 A	1-2002	JP		partial
	2002-2446321 A	8-2002	JP		partial
JLD	2003-107765 A	4-2003	JP		partial

OTHER DOCUMENTS (including Author, Title, Date, Pertinent pages, etc.)

Document	Date	Considered
International Preliminary Report on Patentability mailed November 10, 2005 in corresponding PCT application no. PCT/JP2004/005506		04/27/2008

Examiner: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

Form PTO-FB-A820 (Also PTO-1346)

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Specifically, the Examiner's initials were not included in the column to the left of JP 59-155851 A, JP 2-233769 A, JP 61-28557 A, JP 7-91486 B2, JP 2700859 B2, JP 2000-129155 A, JP 3-128973 A, JP 2000-313819 A, JP 4-372663 A and JP 9-73182 A,

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as noted in the above by the oval. The Examiner is believed to have confirmed consideration of the listed references in the last full sentence of page 4, of the Office Action dated May 1, 2008. A completely initialed PTO 1449 Form is requested to ensure printing of the references on the face of any patent issuing from the present application.

The new matter rejection is obviated by the above amendments, which have been made without prejudice.

The applicants note, with due respect, that the MPEP encourages applicants to include an incorporation-by-reference statement to prior benefit applicants such as was contained in the Preliminary Amendment of October 21, 2005 as a safeguard against the omission of a portion of a prior application for which priority is claimed. Specifically, MPEP § 608.01(p) provides the following (emphasis added):

As a safeguard against the omission of a portion of a prior application for which priority is claimed under 35 U.S.C. 119(a)-(d) or (f), or for which benefit is claimed under 35 U.S.C. 119(e) or 120, applicant may include a statement at the time of filing of the later application incorporating by reference the prior application. See MPEP § 201.06(c) >and § 201.11< where domestic benefit is claimed. See MPEP § 201.13 where foreign priority is claimed. >See MPEP § 201.17 regarding 37 CFR 1.57(a) for applications filed on or after September 21, 2004.< The inclusion of such an incorporation by reference statement in the later-filed application will permit applicant to include subject matter from the prior application into the later-filed application without the subject matter being considered as new matter. For the incorporation by reference to be effective as a proper safeguard, the incorporation by reference statement must be filed at the time of filing of the later-filed application. An incorporation by reference statement added after an application's filing date is not effective because no new

matter can be added to an application after its filing date (see 35 U.S.C. 132(a). See [www.uspto.gov](http://www.uspto.gov) (June 25, 2008).

Similarly, MPEP § 201.13(II)(G.) provides as follows:

**\*\*>**An applicant may incorporate by reference the foreign priority application by including, in the U.S. application-as-filed, an explicit statement that such specifically enumerated foreign priority application or applications are "hereby incorporated by reference." The statement must appear in the specification. See 37 CFR 1.57(b) and MPEP § 608.01(p). For U.S. applications filed prior to September 21, 2004, the incorporation by reference statement may appear in the transmittal letter or in the specification. The inclusion of this statement of incorporation by reference of the foreign priority application will permit an applicant to amend the U.S. application to include subject matter from the foreign priority application(s), without raising the issue of new matter. Thus, the incorporation by reference statement can be relied upon to permit the entering of a portion of the foreign priority application into the U.S. application when a portion of the foreign priority application has been inadvertently omitted from the U.S. application, or to permit the correction of translation error in the U.S. application where the foreign priority application is in a non-English language. See [www.uspto.gov](http://www.uspto.gov) (June 25, 2008).

The applicants submit, with due respect, that the Preliminary Amendment filed October 21, 2005 did not add new matter but rather was submitted at the suggestion and encouragement of the MPEP.

Withdrawal of the new matter rejection is requested.

The specification has been revised to include a capitalized text of the term "AMILAN", as suggested by the Examiner, as well as the terms "FASTOGEN BLUE" and "ESLEC". Withdrawal of the objection to the disclosure is requested.

The Examiner's comments in §6., spanning pages 7-8 are noted. As there is no rejection or objection of the claims or specification stated therein, no further comments

from the applicants in response are believed to be required. The applicants do not necessarily agree with the Examiner's determinations stated on pages 7-8 of the Office Action.

The Section 112, second paragraph, rejection of claims 6-15, 19 and 20 is believed to be obviated by the above amendments. Specifically, claim 6 has been revised, without prejudice, to delete the objected-to recitation. Support for the revision to claim 6 may be found, for example, on page 21, lines 1-3 of the specification. Claim 10 has been revised to include the description of formula (1) from claim 1 and the specification. Claim 19 has been revised, without prejudice, to delete the objected-to recitation. Withdrawal of the Section 112, second paragraph, rejection of claims 6-15, 19 and 20 is requested.

To the extent not obviated by the above amendments, the Section 112, first paragraph "written description", rejection of claims 19 and 20 is traversed.

The applicants submit that one of ordinary skill in the art will appreciate from the present disclosure, including the figures, that the applicants were in possession of the claimed invention, including the controller of claim 19, at the time the application was filed. Figure 7, for example, describes a "control means", which is further described, for example, on page 33, lines 9-15; page 33, line 23 through page 36, line 3; page 120, line 21 through page 121, line 6; and page 126, line 13 through page 127, line 19. The applicants believe that controllers of the sort recited in the claimed invention will be recognized by those of ordinary skill in the art and that one of ordinary skill in the art will be able to make and use the claimed invention without undue experimentation.

Withdrawal of the Section 112, first paragraph "written description", rejection is requested.

The objection to claim 10 stated on page 12 of the Office Action dated May 1, 2008 is obviated by the above amendments. Withdrawal of the objection to claim 10 is requested.

The following documents have been cited by the Examiner in the Office Action of May 1, 2008 as the basis of a rejection and/or provisional rejection:

- D1 - JP2003-12619 (Kobata);
- D2 - U.S. Patent No. 6,210,847 (Miyauchi);
- D3 - U.S. Patent No. 4,898,799 (Fujimaki);
- D4 - U.S. Patent No. 6,270,936 (Tanaka);
- D5 - U.S. Patent No. 5,292,604 (Nukada);
- D6 - U.S. Patent No. 6,489,072 (Sasaki);
- D7 - U.S. Patent No. 5,250,990 (Fujimura);
- D8 - JP08-185089 (Mitsushi);
- D9 - U.S. Patent No. 4,522,483 (Matsumoto);
- D10 - U.S. Patent No. 6,178,303 (Ishii);
- D11 - U.S. Patent No. 7,175,956 (Obata);
- D12 - U.S. Application No. 10/993,770.

Specifically, the Office Action of May 1, 2008 contains the following 18 art rejections, wherein the cited art is identified by the above-noted document, or "D", numbers:

1) Claims 10 and 11 have been rejected under Section 102 as allegedly being anticipated by D1;

2) Claims 1, 16 and 18 have been rejected under Section 102 as allegedly being anticipated by D1;

3) Claim 3 has been rejected under Section 103 as allegedly having been obvious in view of a combination of D1 and D2;

4) Claim 4 has been rejected under Section 103 as allegedly having been obvious in view of a combination of D1 and D3;

5) Claim 5 has been rejected under Section 103 as allegedly having been obvious in view of a combination of D1 and D4;

6) Claims 6-9 have been rejected under Section 103 as allegedly having been obvious in view of a combination of D1 and D5;

7) Claims 12-14 have been rejected under Section 103 as allegedly having been obvious in view of a combination of D1 and D5;

8) Claims 17, 19 and 20 have been rejected under Section 103 as allegedly having been obvious in view of a combination of D1, D7, D8, D9 and D10;

9) Claims 1-3 have been rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-14 of D11 in view of D2;

10) Claims 1, 2 and 4 have been rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-14 of D11 in view of D3;

11) Claims 1, 2 and 5 have been rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-14 of D11 in view of D4;

12) Claims 6-9 and 15 have been rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-14 of D11 in view of D5;

13) Claims 10-14 have been rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-14 of D11 in view of D6;

14) Claims 1-3, 16 and 18 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-5 of D12 in view of D10 and D2;

15) Claims 1, 2, 4, 16 and 18 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-5 of D12 in view of D10 and D3;

16) Claims 1, 2, 5, 16 and 18 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-5 of D12 in view of D10 and D4;

17) Claims 6-9 and 15 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-5 of D12 in view of D5; and

18) Claims 10-14 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-5 of D12 in view of D6.

Reference is made in the following remarks to the above rejections (1) – (18) and documents D1-D12.

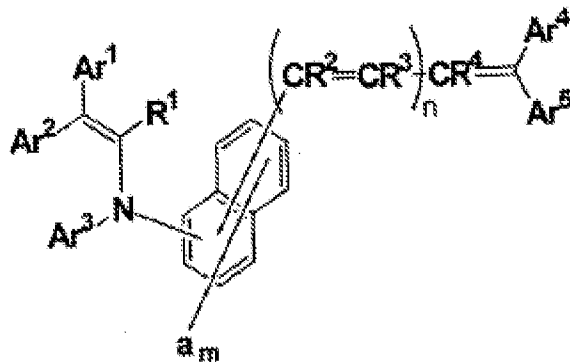


The present Examiner has relied on reference D1 in rejecting claims during prosecution of the co-pending Application No. 11/051,640. The claims of Application No. 11/051,640 have been allowed July 16, 2008. Terminal Disclaimers have been filed in Application No. 11/051,640 over Application Nos. 10/544,454; 10/544,099; 10/559,187; 10/575,097; and 11/593,504.

**Rejection (1)**

Rejection (1) is traversed. Reconsideration and withdrawal of the rejection are requested in view of the following distinguishing comment.

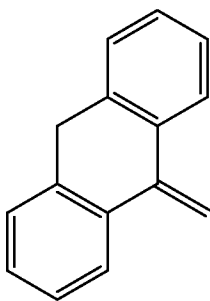
Claims 10 and 11 require an enamine compound represented by the general formula (1)



(1)

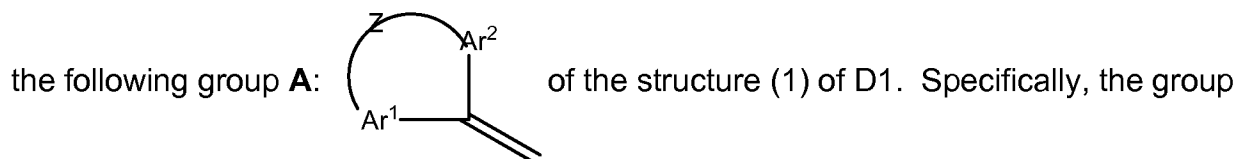
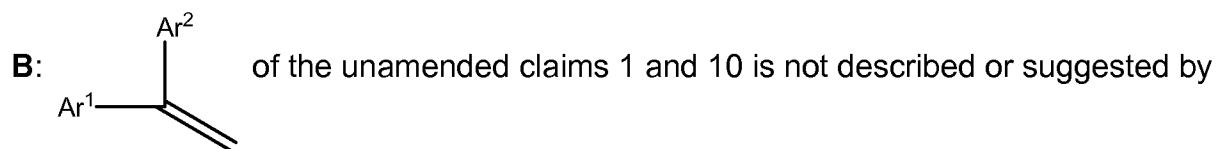
The Examiner directs the applicants attention to compound no. 4 in application example 14 of D1 while admitting that the enamine of compound No. 4 of D1 is not within the compositional limitations of Formula (1) of claims 10 and 11.

Claims 1 and 10 have been revised, without prejudice, to describe Ar<sup>1</sup> and Ar<sup>2</sup> as each representing an aryl group in view of the Examiner's assertion that a definition of Ar<sup>1</sup> and Ar<sup>2</sup> as each representing an aryl group which may have a substituent reads on 9,10-dihydroanthracene derivative (i.e., a group with the following structure which would require a definition of Ar<sup>1</sup> and Ar<sup>2</sup> wherein the substituents Ar<sup>1</sup> and Ar<sup>2</sup> are joined to



form a ring or cyclic structure: ).

As explained to present Examiner during the prosecution of copending Application No. 11/051,640, wherein the present Examiner similarly interpreted D1 and similar Ar<sup>1</sup> and Ar<sup>2</sup> structures of an enamine included in the claims, the following group



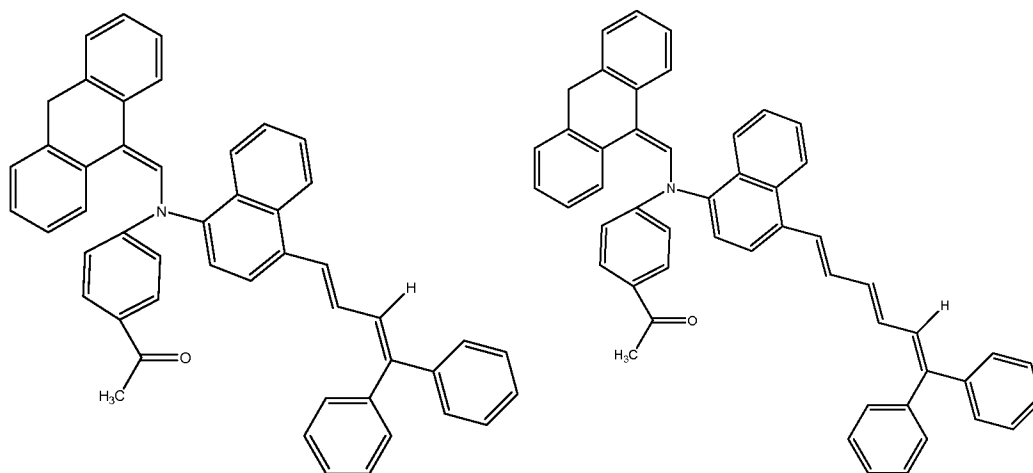
**A** of structure (1) (and all of the structures and description) of D1 include a fusion of groups Ar<sup>1</sup> and Ar<sup>2</sup> of the structure (1) of D1. The group **B** however of the present claim 1 requires two separate groups which “each represent an aryl group which may have a substituent”. There is no teaching or suggestion in the present specification which

would lead one of ordinary skill in the art to reasonably conclude that group **B** could read on group **A** of the structure (1) of D1 wherein groups Ar<sup>1</sup> and Ar<sup>2</sup> of the structure (1) of D1 are fused through Z.

In fact, the definition of Ar<sup>1</sup> and Ar<sup>2</sup> of unamended claims 1 and 10 of the present application may be contrasted with the definitions of Ar<sup>4</sup> and Ar<sup>5</sup> of claims 1 and 10 of the present application which may be bonded to each other via an atom or an atomic group to form a cyclic structure. One of ordinary skill in the art will appreciate that the lack of a similar statement that Ar<sup>1</sup> and Ar<sup>2</sup> of formula (1) of claims 1 and 10 may bond to each other via an atom or an atomic group to form a cyclic structure, is further evidence that the present applicants have not defined their invention as including a structure wherein Ar<sup>1</sup> and Ar<sup>2</sup> of formula (1) of claims 1 and 10 may combine to form a structure of group **A** of the structure (1) of D1.

The compositional requirements of unamended claims 1 and 10 are not believed to be anticipated or suggested by D1.

The Examiner has interpreted Ar<sup>1</sup> and Ar<sup>2</sup> in the following Compounds 98 and 99 of D1 as allegedly being "phenyl groups that are connected to each other via a carbon atom" (see page 15 of the Office Action dated May 1, 2008):



The Examiner concludes that these structures meet the alleged requirement in claim 10 of “Ar<sup>1</sup> and Ar<sup>2</sup> each represent an optionally-substituted aryl group” Id. The Examiner is requested to appreciate however that the unamended claims 1 and 10 defines “Ar<sup>1</sup> and Ar<sup>2</sup> each represent an aryl group which may have a substituent”. Under the Examiner’s interpretation of the unamended claims 1 and 10, the “Z” of formula (1) of D1 is a carbon atom which is a “substituent” of “each” of Ar<sup>1</sup> and Ar<sup>2</sup>. The applicants submit, with due respect, that such an interpretation of the language of unamended claims 1 and 10 is not a reasonable interpretation which would be made by one of ordinary skill in the art.

Claims 1 and 10 have been amended to advance prosecution.

Withdrawal of rejection (1) is requested.

### **Rejection (2)**

Rejection (2) is traversed. Reconsideration and withdrawal of the rejection are requested in view of the above-noted distinctions over D1. D1 fails to teach each and

every aspect of the rejected claims 1, 16 and 18, as interpreted by the Examiner.

Withdrawal of rejection (2) is requested.

**Rejections (3)-(8)**

Rejections (3)-(8) are traversed. Reconsideration and withdrawal of the rejections are requested as the secondary references D2-D10, individually with D1 or in the combinations with D1 applied by the Examiner, fail to cure the deficiencies of D1 noted above. In each of the rejections (3)-(8) the Examiner relies on the basis advanced in rejections (1) and (2) with regard to the enamine compound of claims 1 and 10. See page 19, 2<sup>nd</sup> paragraph; page 20, 1<sup>st</sup> paragraph; page 21, 3<sup>rd</sup> full paragraph; page 23, 3<sup>rd</sup> full paragraph; page 25, 3<sup>rd</sup> full paragraph; and page 27, 2<sup>nd</sup> full paragraph, of the Office Action dated May 1, 2008. Withdrawal of rejections (3)-(8) is requested.

**Rejections (9)-(18)**

Rejections (9)-(18) are obviated by the attached Terminal Disclaimers and related fees. The attached Terminal Disclaimers are being filed without prejudice, to advance prosecution. Entry of the attached Terminal Disclaimers and withdrawal of rejections (9)-(18) are requested.

The claims are submitted to be in condition for allowance and a Notice to that effect is requested. The Examiner is requested to contact the undersigned, preferably by telephone, in the event anything further is required in this regard.

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Respectfully submitted,

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